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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,836	04/02/2004	Christian Galea	119339	8842

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EXAMINER

DOUYON, LORNA M

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/815,836

Applicant(s)

GALEA, CHRISTIAN

Examiner

Lorna M. Douyon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/17/04.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 112

1. Claims 18, 21, 22, 25-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 is indefinite in the recital of the term “sucrose ester type” in lines 2-3. The addition of the word “type” to an otherwise definite expression extends the scope of the expression so as to render it indefinite, see *Ex parte Copenhaver*, 109 USPQ 118 (Bd. App. 1955). See also MPEP 2173.05(b)(e).

Claim 21 is indefinite in the recital of “or a mixture of these” because there is only one recited component. In addition, could it be that the recited thickener is an “ether” and not an “ester”?

In claim 22, line 2, the phrase “the dispersant” lacks support with respect to claim 20. Presumably this claim should depend from claim 17.

Claims 25-27 provides for the use of benzyl acetate or stripping composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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3. Claims 25-27 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olson et al. (US Patent No. 6,472,027), hereinafter "Olson".

Olson teaches a stripper composition which contains a polar solvent, and suitable polar solvents include, among others, benzyl acetate, diacetone alcohol, isophorone and methyl ethyl ketone (see col. 3, lines 46-55, line 59; col. 4, lines 5-6 and 15). Another useful subclass of stripper composition contains a blend of primary solvent and one or more ether alcohol solvent couplers in the substantial absence of water (see col. 4, lines 56-59). Olson, however, fails to specifically disclose a stripper composition comprising benzyl acetate and at least one of diacetone alcohol, isophorone and methyl ethyl ketone.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare a stripper composition comprising benzyl acetate and diacetone alcohol, isophorone and/or methyl ethyl ketone because each of these solvent is taught by Olson as a suitable polar solvent and it is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose, see *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

6. Claims 1-6, 17 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takayanagi et al. (US Patent No. 5,612,303).

Takayanagi teaches a solvent composition suitable for use as a solvent or an assistant in paints and varnishes, coatings, adhesives, printing inks, cleaning agents and cosmetics (see col. 1, lines 8-12), which comprises, as an active component, at least one oxyisobutyric acid ester (see col. 3, line 54+) in amount not less than 10% by weight and other organic solvents (see col. 5, lines 57-53), which is understood to be the remainder of the composition. The other solvents include, among others, isophorone, N-methyl pyrrolidone, dimethyl sulfoxide, benzyl acetate, propylene glycol monomethyl ether acetate (equivalent to methoxypropyl acetate) (see col. 5, line 54 to col. 6, line 20). The organic solvents may be used either individually or in combination of two or more thereof (see col. 10, lines 23-24). When used as a cleaning agent, a surface active agent such as nonionic surface active agent is added (see col. 1, lines 5-8), which reads on dispersant. Takayanagi, however, fails to specifically disclose a solvent composition comprising

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benzyl acetate and at least one of diacetone alcohol, isophorone and methyl ethyl ketone, N-methyl pyrrolidone or dimethyl sulfoxide in their recited amounts.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare a solvent composition comprising benzyl acetate, diacetone alcohol, isophorone and/or methyl ethyl ketone, N-methyl pyrrolidone or dimethyl sulfoxide because Takayanagi teaches that the organic solvents can be used in combination. With respect to their individual proportions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select the portion of the prior art's range which is within the range of applicant's claims because it has been held to be obvious to select a value in a known range by optimization for the best results. As to optimization results, a patent will not be granted based upon the optimization of result effective variables when the optimization is obtained through routine experimentation unless there is a showing of unexpected results which properly rebuts the *prima facie* case of obviousness. See *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). See also *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990), and *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

7. Claims 1-22 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lallier et al. (US Patent No. 6,656,896), hereinafter "Lallier" in view of Olson or Takayanagi.

Lallier teaches a stripping composition suitable for stripping external organic coatings which contains (A) 5 to 50 parts by weight of at least one dibasic ester, e.g. aliphatic esters (B) 10 to 60 parts by weight of at least one dipolar aprotic solvent, e.g. dimethyl sulfoxide, (C) 10 to 50 parts by weight of at least one cosolvent and (D) 0.3 to 10 parts by weight of a combination of

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softening agents and water (see abstract). The dibasic ester or esters are shown in particular from aliphatic dibasic esters such as dimethyl succinate, dimethyl glutarate, dimethyl adipate and their mixtures (see col. 1, lines 44-48). The "combination of softening agents" preferably denotes a mixture comprising an alkyl lactate an ethanolamine such as diethanolamine (which reads on the activator) and water (see col. 1, lines 58-64). The stripping composition can additionally comprise, per 100 parts by weight of (A)+(B)+(C)+(D), at least one inorganic filler with a thickening nature, in a proportion of 20 to 60 parts by weight, for example, calcium carbonate, calcium phosphate, calcium hydroxide, clay or bentonite; and/or at least one cellulose thickener, in a proportion of 0.05 to 1.5 parts by weight, for example, hydroxypropyl methyl cellulose ether; and/or dispersing agent, in a proportion of 0.1 to 10 parts by weight, for example, the acidic phosphoric ester of 2-ethylhexanol (see col. 2, lines 1-35). The presence of thickener would allow the composition to be prepared in the form of a gel or cream. Lallier, however, fails to disclose the incorporation of benzyl acetate and the proportions on the ingredients in amounts as those recited.

Olson teaches a similar composition comprising solvents like benzyl acetate (see col. 3, lines 46-59).

In the alternative, Takayanagi teaches a similar composition comprising benzyl acetate as one useful solvent (see col. 6, line 12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate benzyl acetate into the stripper composition of Lallier because Lallier specifically desires at least one cosolvent, and Olson or Takayanagi teaches benzyl acetate as one useful solvent for stripper composition which solvent, when added, would provide additive effect

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to the stripping composition. With respect to the proportions of each of the individual components, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select the portion of the prior art's range which is within the range of applicant's claims because it has been held to be obvious to select a value in a known range by optimization for the best results. As to optimization results, a patent will not be granted based upon the optimization of result effective variables when the optimization is obtained through routine experimentation unless there is a showing of unexpected results which properly rebuts the *prima facie* case of obviousness. See *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). See also *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990), and *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Conclusion


8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references are considered cumulative to or less material than those discussed above.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lorna M. Douyon whose telephone number is (571) 272-1313. The examiner can normally be reached on Mondays-Fridays from 8:00AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Lorna M. Douyon
Primary Examiner
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